

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT LAWTON, THOMAS PATRICK O'CONNOR, JR.,
BARBARA ANN BARTOL, and PAUL SCOTT M^{AC}HENRY

Appeal No. 2005-1610
Application No. 10/054,354

ON BRIEF



Before MILLS, GRIMES and GREEN, Administrative Patent Judges.

MILLS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is a decision on appellants' request for rehearing of our earlier decision entered December 22, 2005, wherein we affirmed the examiner's final rejection of claims 1 through 6 under 35 U.S.C. §§ 102 and 103 as unpatentable Rikihisa and Waner.

Claim 1 is illustrative of the claims on appeal and reads as follows:

1. A composition of matter comprising an isolated polypeptide consisting essentially of SEQ ID NO:1 and amino acid substitution variants thereof that specifically bind to an anti-*Ehrlichia* antibody..

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The prior art references cited by the examiner are:

Rikihisa et al. (Rikihisa) WO 99/13720 Mar. 25, 1999

Waner, T, et al., "Comparison of a Clinic-based ELISA test kit with the Immunofluorescence test for the Assay of *Ehrlichia canis* antibodies in Dogs," Journal of Veterinary Diagnostic Investigation, Vol. 12, pp. 240-244 (2000)

Grounds of Rejection Maintained

Claims 1-3 stand rejected under 35 U.S.C. 102(a), as anticipated by Rikihisa.

Claims 1-6 stand rejected under 35 U.S.C. 103(a), as obvious over Rikihisa in view of Waner.

DISCUSSION

We find no error in our Decision of December 22, 2005 and therefore, we decline to grant the relief requested or change our earlier decision in any way.

Appellants request that we read portions of the description and features from the specification into the claims. Request for Reconsideration, page 6. We decline to do so.

Appellants now argue that the specification indicates that adding additional amino acids "to the claimed polypeptides ... would be detrimental to the sensitivity and specificity of assays for the detection of Ehrlichia antibodies." Request, page 7. However, appellants chose not to use the transitional phrase "consisting of" in the claim which would have precluded the addition of amino acids to the claimed sequence. "A 'consisting essentially of' claim occupies a middle ground between closed claims that

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are written in a 'consisting of' format and fully open claims that are drafted in a 'comprising' format." PPG Industries v. Guardian Industries, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). Thus, appellants claim scope is by definition, at least broader than the SEQ ID NO:1 sequence itself. Moreover, absent a clear indication in the specification or claims of what the basic and novel characteristics of the claimed polypeptide actually are, the term "consisting essentially of" is construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355.¹

Appellants have not defined in the specification the claim scope or scope of the invention proscribed by the claim term "consisting essentially of." We remind appellants that it is their burden to precisely define the invention, not the PTO's. In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997). Appellants always have the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 51 (CCPA 1969).

¹ In re Crish, 393 F.3d 1253, 1256, 73 USPQ2d 1364,1367 (Fed. Cir. 2004) was cited in the Decision for the comparative proposition that when a specific sequence is interpreted in view of "comprising" claim language, additional amino acids are possible at either end of the sequence.

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Appellants have asserted that a characteristic of the isolated polypeptide and its variants is its ability to bind to an anti-Ehrlichia antibody. Appellants have the burden to show that the introduction of additional components would materially change the characteristics of their invention or whether such components are excluded from their claims. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). Appellants have not met this burden. Appellants have not shown that whole Ehrlichia proteins encompassed by the claim scope do not have the ability to bind to an anti-Ehrlichia antibody, a characteristic of the sequence and sequence variants appellants have claimed. Appellants have not recited a specific sensitivity and/or specificity for the polypeptide of SEQ ID NO:1 in the claims to distinguish the claimed sequence from whole Ehrlichia proteins.

We decline to import limitations from the specification that are not part of the claim into the claims before us, as requested by appellants. The Request for Reconsideration is denied.

CONCLUSION

Therefore, the request for reconsideration is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

Demetra J. Mills
DEMETRA J. MILLS
Administrative Patent Judge

ERIC GRIMES
Administrative Patent Judge


LORA M. GREEN
Administrative Patent Judge
INTERFERENCES

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